

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-4, 6-7, 9, 18-20 and 22-28 are presently active in this case. Claims 7 and 17 were cancelled by a previous amendment. The present Amendment amends Claims 1-4, 6-7, 9, 18-20 and 22; and adds new Claims 23-28 without introducing any new matter; and cancels Claims 5, 10-16, and 21 without prejudice or disclaimer.

The outstanding Office Action rejected Claims 18-22 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-7, 9-16, and 18-22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Walker et al. (U.S. Patent No. 5,794,207, hereinafter “Walker”) in view of Mangin et al. (U.S. Patent No. 6,078,890, hereinafter “Mangin”), in further view of Case et al. (U.S. Patent No. 6,510,418, hereinafter “Case”).

To correct some formal issues and to better comply with U.S. claim drafting practice, Applicants’ Claims 1-4, 6-7, 9, 18-20 and 22 are amended to recite a standard processing unit and a non-standard processing unit that are functional units provided by the server. These features find non-limiting support in Applicants’ disclosure as originally filed, for example in Figures 3-5, and in the specification from page 15, line 7, to page 16, line 2. (See also Applicants’ Fig. 4, processes A and B, and Fig. 5, ref. num. 520, 530.) No new matter has been added. In addition, Claims 5, 10-16, and 21 are cancelled without prejudice or disclaimer.

Moreover, to address the rejection of Claims 18-22 under 35 U.S.C. § 101, independent method Claim 18 is amended to be directed to a method of transacting business between a solicitor and a business, the method performed on a server that includes at least one hardware processor. These features find non-limiting support in Applicants’ disclosure as originally filed, for example at page 3, lines 4-11, and page 6, lines 1-7, and in Figure 1.

No new matter has been added. The recent *In re Bilski* decision requires that a claimed software method be either (1) tied to a particular machine or apparatus, or (2) able to transform particular article into a different state or thing. 545 F.3d at 979. *See also Guidance for Examining Process Claims in view of In re Bilski*, Memorandum from John J. Love, Deputy Commissioner for Patent Examination Policy, (Jan. 7, 2009). Because the method steps of independent Claim 18 are now tied to a particular machine, Applicants respectfully traverse the rejection under 35 U.S.C. § 101, and request reconsideration thereof.

Moreover, new Claims 23-28 are added. New Claims 23-28 are directed to a computerized device, and find analogous features as currently recited in Claims 1-4 and 6-7. No new matter has been added with these new claims.

In response to the rejection of Claim 1 under 35 U.S.C. § 103(a), Applicants respectfully request reconsideration of this rejection and traverse the rejection, as discussed next.

Briefly summarizing, Applicants' independent Claim 1 is directed to a system for transacting business between a solicitor and a business. The system includes a server used by the business and accessible by the solicitor; and a contract evaluation unit, a standard processing unit, and a non-standard processing unit, wherein the standard processing unit is configured to process data by an automatic process, and the non-standard processing unit is configured to process data with human intervention by an additional data input. Moreover, the contract evaluation unit is configured (i) to receive input data from the solicitor, (ii) to determine whether the input data is complete and error free in accordance with error validation criteria, and (iii) to evaluate whether the complete input data has to be further processed by the standard processing unit or the non-standard processing unit.

In addition, the complete input data is sent for further processing to the standard processing unit in a case where the contract evaluation unit determines that the complete

input data fits a predetermined acceptable range, the predetermined acceptable range being an ideal range of acceptable premiums, and where the complete input data includes at least a premium from the solicitor, the complete input data is sent for further processing to the non-standard processing unit in a case where the contract evaluation unit determines that the complete input data falls outside of the predetermined acceptable range, and where the complete input data requires human intervention.

Turning now to the applied reference, Walker is directed to a computerized method of performing a bilateral buyer-driven commerce, where a potential buyer can communicate binding purchase offers 100 (conditional purchase offers, “CPO”) to potential sellers. (Walker, Abstract, Fig. 1, col. 8, ll. 42-65.) Walker explains that a central controller 200 has communication interfaces to buyers 400 and sellers 300, and manages a data storage device 250 that will store CPOs made by buyers. (Walker, Fig. 2, col. 12, ll. 8-34 and ll. 54-67.) Moreover, Walker explains how a CPO 100 is activated and made available to potential sellers, and the CPOs 100 are labeled by a status, such as “pending,” “active,” “expired,” etc. (Walker, col. 17, ll. 48-64.) The CPOs 100 then go through some steps of processing, where the CPOs may be translated, proofread, and checked for clarity. (Walker, col. 18, ll. 1-14.) Next, the CPOs 100 are shown to appropriate sellers, based on a “subject field” associated with the CPOs. (Walker, col. 18, ll. 15-33.)

However, Walker fails to teach all the features of Applicants’ independent Claim 1. In particular, Walker fails at least to teach the following features:

contract evaluation unit is configured . . . to evaluate whether the complete input data has to be further processed by the standard processing unit or the non-standard processing unit,

the complete input data is sent for further processing to the standard processing unit in a case where the contract evaluation unit determines that the complete input data fits a predetermined acceptable range, the predetermined acceptable range being an ideal range of acceptable premiums, and where the complete input data includes at least a premium from the solicitor,

(Claim 1, portions omitted.) The cited passages of Walker are silent on such features.

The reference Mangin, used by the pending Office Action to form a 35 U.S.C. § 103(a) rejection, fails to remedy the deficiencies of Walker, even if we assume that the combination is proper. Mangin is directed to an automated health care rate renewal method, where an electronic form is filled out by a user, that has locked embedded formulas to perform certain calculations to determine a health care package. (Mangin, Fig. 2, Abstract.) Mangin explains that the electronic form can include programming that analyzes the form to determine whether the provider failed to fully input all requested data into the form, and an alert can be provided to return the form to the user. (Mangin, col. 4, ll. 1-11.) However, Mangin, just like Walker, fails to teach that the complete data can be sent to either a the standard processing unit or the non-standard processing unit, and the complete input data is sent for further processing to the standard processing unit in a case where the contract evaluation unit determines that the complete input data fits a predetermined acceptable range, the predetermined acceptable range being an ideal range of acceptable premiums, as required by Applicants' independent Claim 1.

Therefore, even if the combination of Walker and Mangin is assumed to be proper, the cited passages of the combination fails to teach every element of Applicants' Claim 1. Accordingly, Applicants respectfully traverse, and request reconsideration of this rejection based on these references.

Independent Claims 18 and 23 recite features that are analogous to the features recited in independent Claim 1, but directed to different statutory classes. Moreover, Claims 18 and 23 have been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejections of Claims 18 and 23, and the rejections of all associated dependent claims, are also believed to be overcome in view of the arguments regarding independent Claim 1.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-4, 6-7, 9, 18-20 and 22-28 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Nikolaus P. Schibli, Ph.D.
Registered Patent Agent
Registration No. 56,994

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/09)